REMARKS

Applicants submit the following Preliminary Amendment with a Request for Continued Examination.

In the Final Office Action mailed December 28, 2009, the Examiner rejects claims 1-12, 14-23 and 34-44 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 24-31, 45-50, 52 and 53 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2002/0123928 to Eldering, et al. ("Eldering"). Claims 1-12, 14, 15, 17-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,169,542 to Hooks, et al. ("Hooks") in view of Eldering. Claims 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,588,013 to Lumley, et al. ("Lumley") in view of Hooks. Claims 45-50, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering in view of U.S. Patent No. 6,941,573 to Cowan, et al. ("Cowan"). Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hooks in view of Eldering in further view of U.S. Patent Publication No. 2003/0130887 to Nathaniel ("Nathaniel") and in further view of U.S. Patent Publication No. 2002/0161609 to Zizzamia, et al. ("Zizzamia"). Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering in view of U.S. Patent Publication No. 2003/0154128 to Liga, et al. ("Liga"). Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering in view of Cowan. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering in view of Hooks and Cowan. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lumley in view of Hooks and Liga. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering in view of Hooks.

Claims 1-12, 14-20, 23-41, 43-50, 52 and 53 are currently pending in the present application, with claims 1, 24, 34, 43, 45, 49 and 50 being independent claims. By way of the present Response, Applicants hereby amend claim 1, 34, 43 and 44. Accordingly, no new matter has been added and the amendments are supported by the specification as originally filed. For at least the reasons set forth below, Applicants respectfully submit that all pending claims are allowable and respectfully request withdrawal of the rejection of claims 1-12, 14-20, 23-41, 43-50, 52 and 53.

Claims 1 – 12, 14 – 23 and 34 – 44 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts that the recitation of a "time shifted program" in independent claim 1 is indefinite because it lacks a clear definition. While Applicants respectfully disagree with the Examiner's rejection as a "time shifted program" is a term commonly known in the art, Applicants have amended independent claim 1 to recite "a user requested program stored in the video time shifting architecture," making the present rejection moot.

The Examiner also takes issue with the recitation of the term, "properly zoned" in independent claim 43, asserting that such term is indefinite as it lacks a clear definition. Applicants have amended independent claim 43 to recite "a zoned copy of a given program containing proper local advertising for each zone the video distribution system services," making the present rejection moot.

Applicants additionally note that it is unclear as to the basis for the Examiner's rejection of independent claim 34 and dependent claims 35-41 under 35 U.S.C. § 112, second paragraph, as the aforementioned claims do not claim dependency from either independent

claims 1 or 43, nor do the claims recite the accused indefinite language. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejections under 35 U.S.C. § 112, second paragraph as to claims 1 – 12, 14 – 23 and 34 – 44.

Claims 24-31, 45-50, 52 and 53 are rejected under 35 U.S.C. § 102(b) as being anticipated by Eldering. As understood, Eldering is directed at a system, method and apparatus for targeting advertisements (ads) to subscribers. The Eldering system targets ads to subscribers by correlating subscriber profiles with ad profiles. The subscriber profiles identify characteristics and/or traits associated with the subscriber and the ad profiles identify characteristics and/or traits about an intended target market for the ad. (Eldering, ¶ [0024]). Eldering, however, fails to disclose each and every element of independent claims 24, 45, 49 and 50. Specifically, with respect to independent clam 24, Eldering fails to disclose, *inter alia,* "determining whether the geographically zoned local advertisement has expired and replacing an expired geographically zoned local advertisement with a replacement advertisement." Similarly, independent claims 45, 49 and 50 recite method steps directed to associating one or more local advertisements with the given program wherein the one or more local advertisements include a zone identifier proximate to the geographical zone and determining whether the geographically zoned local advertisement has expired and replacing an expired geographically zoned local advertisement with a replacement advertisement.

In rejecting the aforementioned claim element with respect to independent claim 24, the Examiner relies upon (i) Eldering's discussion of heuristic rules that are used to define demographic characteristics, subscriber interests and psychological characteristics (Eldering, ¶ [0122]); (ii) Eldering's discussion of an ad que defining certain characteristics of when ad should be played (Eldering, ¶ [0184]) and (iii) Eldering's discussion of a Secure Correlation

Server that creates presentation streams that includes original programming with targeted ads in place of default advertisements (Eldering, ¶ [0086]). Applicants are unsure as to relevance of (i) defined subscriber interests generated by heuristic rules, (ii) a que directed to when ads should be played and (iii) presentation steams that include targeted advertisements, to the claimed method steps directed to replacing advertisements **upon a determination** that the originating advertisements have **expired**.

As presented previously, Eldering fails to disclose a system or method that even suggests advertisements that may expire and replacing the expired advertisements with one or more replacement advertisements. Applicants submit that the Examiner's comments on page 7 of the present Office Action indicate that the reliance upon Eldering as disclosing the concept of expired advertisements is based on the Secure Correlation Server, the action of which "the Examiner construes . . . as the expiring of the default advertisement in favor of the selected targeted advertisement." However, Eldering is directed to presenting targeted advertisements in lieu of default advertisements based upon subscriber profiles, not upon a temporal characteristic such as the expiration of an advertisement.

Stated simply, Applicants submit it is improper and unreasonable to assert that Eldering's discussion of having favored advertisements identically discloses the active confirmation of an expiration of an advertisement. The Eldering approach provides the same result of an advertisement being available for the user, but the manner in achieving this result is completely and entirely separate. To further emphasize the differences, if in the Eldering system an advertisement is outdated, e.g. it is for a sale that lasts over a period of time, and the Secure Correlation Server does not yet receive a more favored advertisement, the outdated advertisement will still be selected. The inclusion of an expiration provides that the

advertisement is not made a default ad unless something better comes along (the Eldering system), but rather if it is outdated, the system knows it is outdated and replaces the outdated information.

In other words, the Eldering system does not determining whether the advertisement has expired, it merely hopes that an outdated advertisement is replaced in time with a more favored advertisement. Thus, clearly a patentably distinct difference rendering the present rejection improper.

Accordingly, Applicants respectfully request withdrawal of the rejection of independent claims 45, 49 and 50 and allowance of the same.

Claims 1-12, 14, 15, 17-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooks in view of Eldering. Hooks is directed to methods and systems for delivering advertising through a head end facility configured to transmit advertisements in connection with an interactive video program. (Hooks, Col. 2, ll. 51-57). The combination of prior art references, however, fails to teach or suggest each and every element of independent claim 1, as currently amended. Specifically, with respect to independent clam 24, Eldering fails to disclose, *inter alia*, "an advertisement management system (AMS) . . . further operative to determine whether the one or more selected advertisements have expired and to request one or more replacement advertisements for the one or more selected advertisements that have expired."

In rejecting the aforementioned claim element, the Examiner again relies upon Eldering's discussion of a Secure Correlation Server that creates presentation streams that includes original programming with targeted ads in place of default advertisements (Eldering, ¶ [0086]), which Applicants previously submitted fails to teach or suggest the aforementioned claim element, *supra*. In the Response to Argument section, the Examiner additionally asserts

that the aforementioned claim element is taught by Hooks' discussion of providing supplementary advertising information, wherein advertisement menus are maintained in the head end facility, allowing a subscriber to save and retrieve supplemental advertising for an extended period of time (Hooks, Col. 14, ll. 28-45), which the Examiner construes as an indication of being finite and therefore having a time limit or expiration. (Office Action, 12/28/20009, Response to Arguments, p. 44).

The Examiner further asserts that Hooks' discussion of a menu database of a head end facility which includes menus associated with interactive video subscriber units, wherein the head end facility maintains and updates each of the menus where entries to the menu database are added and removed in response to requests from any of various interactive video subscriber units (Hooks, Col. 9:39 – 52), which the Examiner construes as sufficient to establish advertisement replacement. (Office Action, 12/28/20009, Response to Arguments, p. 44).

Applicants submit that the mere fact that advertisements are available for a period of time does not teach or suggest the concept or notion of expired advertisements, nor does such a feature lend itself to teaching or suggesting the **determination** of "whether the one or more selected advertisements have expired and to request one or more replacement advertisements for the one or more selected advertisements that have expired."

Although the Examiner relies upon Hooks' discussion of the maintenance and update of menus where advertisement entries to the menu database are added and removed in response to requests from any of various interactive video subscriber units, such a system fails to teach or suggest a system that (i) makes a determination as to whether advertisements are expired and (ii) request and present replacement advertisements for those advertisements that are expired.

Hooks' menu database is clearly directed toward a system that performs its action in response to user activity and does not involve a system that makes an independent determination of a temporal characteristic and performs a replacement action based upon such a determination. Stated simply, there is no temporal component to the Hooks' system that could support the denial of patentability of patent protection for the recited invention of claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 1 and allowance of the same.

Claims 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lumley in view of Hooks. As understood, Lumley is directed to a promotional video system in which promotional events are logged in a promotional event log that is used to automatically update a promotional material selection algorithm. Lumley's promotional material selection algorithm script allegedly uses selection parameters such as promotional material attribute and detectable environmental situation parameters.

In contrast, none of the promotional material attributes or detectable environment situation parameters discussed by Lumley include any mention of the expiration of local advertisements. The AMS, as currently amended by Applicants, is operative "to determine whether the one or more geographically zoned advertisements have expired and to request one or more replacement advertisements for the one or more geographically zoned advertisements." As such, Applicants respectfully submit that Lumley fails to identically disclose each and every element of independent claim 34 as claimed.

As understood by Applicants, the Examiner's rejection of the aforementioned claim element is based upon the combination of Hooks and Eldering. (Office Action, 12/28/20009, Response to Arguments, p. 46), which Applicants previously submitted fails to

teach or suggest the aforementioned claim element, *supra*. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 34 and allowance of the same.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering in view of Hooks. Claim 43 has been amended to recite the method step, "electronically determining, by using a programmable microprocessor, whether the proper local advertising contained in the zoned copy of the requested program has expired and replacing the expired proper local advertising with a replacement advertisement." As Applicants have previously submitted, the combination of Eldering and Hooks fails to teach or suggest "determining . . . whether . . . advertising . . . has expired and replacing the expired proper local advertising with a replacement advertisement," *supra*. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 43 and allowance of the same.

Applicants have conducted a thorough review of Hooks, Eldering, and Lumley assert that Hooks, Eldering, Lumley and the prior art of record, either alone or in combination, fail to disclose each and every element of independent claims 1, 24, 34, 43, 45, 49 and 50. Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claims 1, 24, 34, 43, 45, 49 and 50 and allowance of the same.

The dependent claims of the present application contain additional features that further substantially distinguish the invention of the present application over the prior art of record. Given the Applicants' position on the patentability of the independent claims, however, it is not deemed necessary at this point to delineate such distinctions.

For at least all of the above reasons, Applicants respectfully request that the Examiner withdraw all rejections, and allowance of all the pending claims is respectfully solicited. To expedite prosecution of this application to allowance, the Examiner is invited to call the Applicants' undersigned representative to discuss any issues relating to this application.

Respectfully submitted,

Dated: April 20, 2010

THIS CORRESPONDENCE IS BEING SUBMITTED TO THE US PATENT AND TRADEMARK OFFICE THROUGH THE PATENT AND TRADEMARK OFFICE EFS FILING SYSTEM ON April 20, 2010.

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